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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/350,197 07/08/99 MONROE

D 58959.10.23

WM01/0810

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EXAMINER

CUMMING, W

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 08/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/350,197	MONROE, DAVID A.	
	Examiner	Art Unit	
	WILLIAM D. CUMMING	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2000.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe and/or fails to originally support the now claimed operation conditions is the determination of whether the transmission is occurring peak or off peak periods as stated by claim 27.

3. Claims 8, 27, and 30 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an enabling disclosure on how the wired transmission is an internet connection as stated in claim 8.

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The specification fails to provide an enabling disclosure on how the method can determine as one of the operation conditions whether the transmission is occurring during peak or off-peak periods as stated by claim 27.

The specification fails to provide an enabling disclosure on how the connector of supporting an internet, ethernet or LAN connection as stated by claim 30.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-12, 15, 16, 18-26, 33-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **O'Sullivan**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

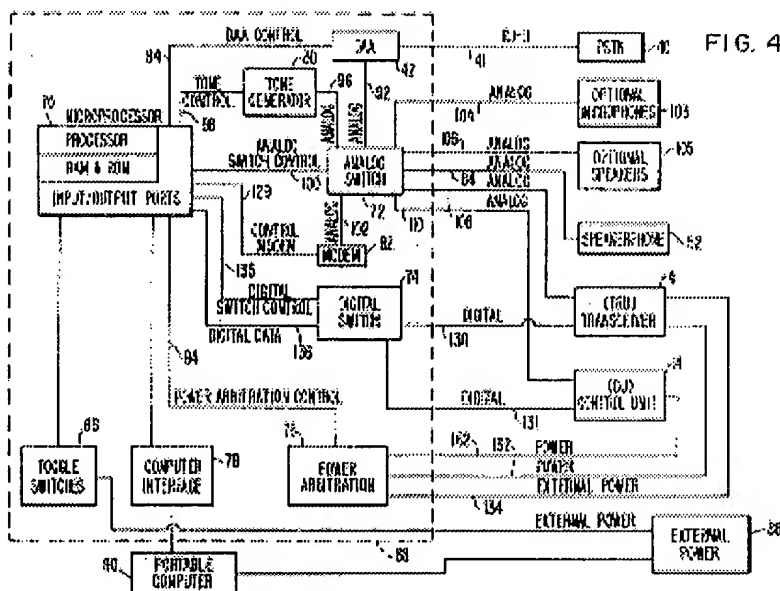
This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be

*"essential to point out the invention defined by the claim."* Kropa v. Robie, 187

F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



6. Claims 1, 2, 4, 6, 7, 9-17, 25, 26, 28, 29, 33-37, and 43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Gillig, et al.**

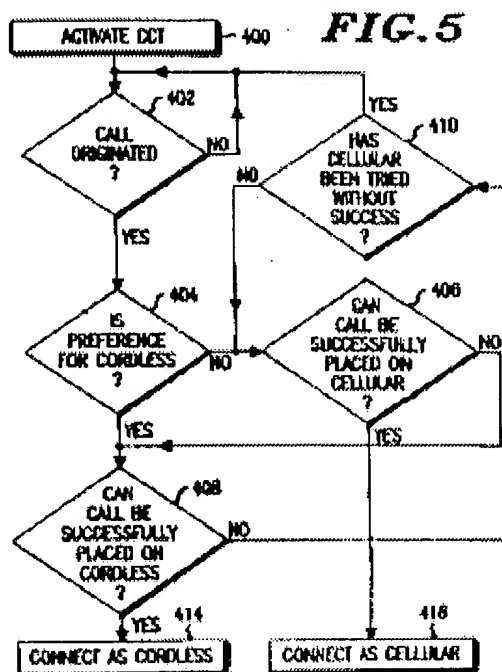
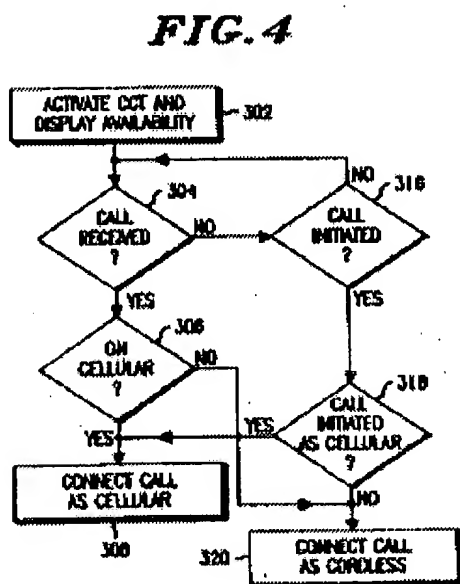
The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



7. Claims 1, 2, 4, 6, 7, 9-17, 25, 26, 28, 29, 33-37, and 41-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Schellinger, et al**, (United States Patent 5,260,988).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The



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following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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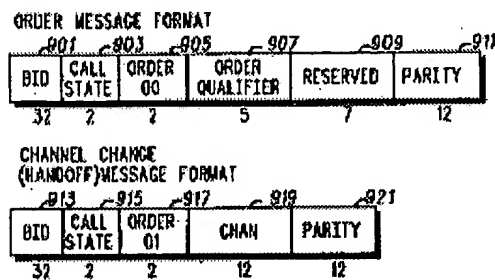


FIG. 9

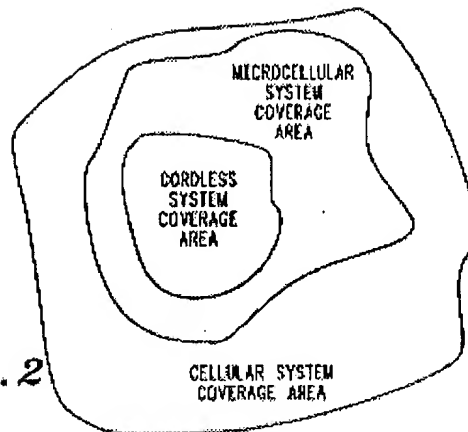


FIG. 2

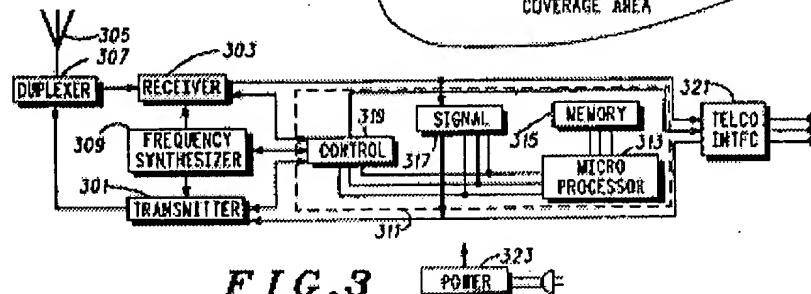


FIG. 3

8. Claims 1-4, 12-17, 23, 26, 28, and 33-36, and 43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Fyfe, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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- (A) statements of intended use or field of use,
- (B) *"adapted to"* or *"adapted for"* clauses,
- (C) *"wherein"* clauses, or
- (D) *"whereby"* clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is *"capable of"* performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be *"essential to point out the invention defined by the claim."* *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

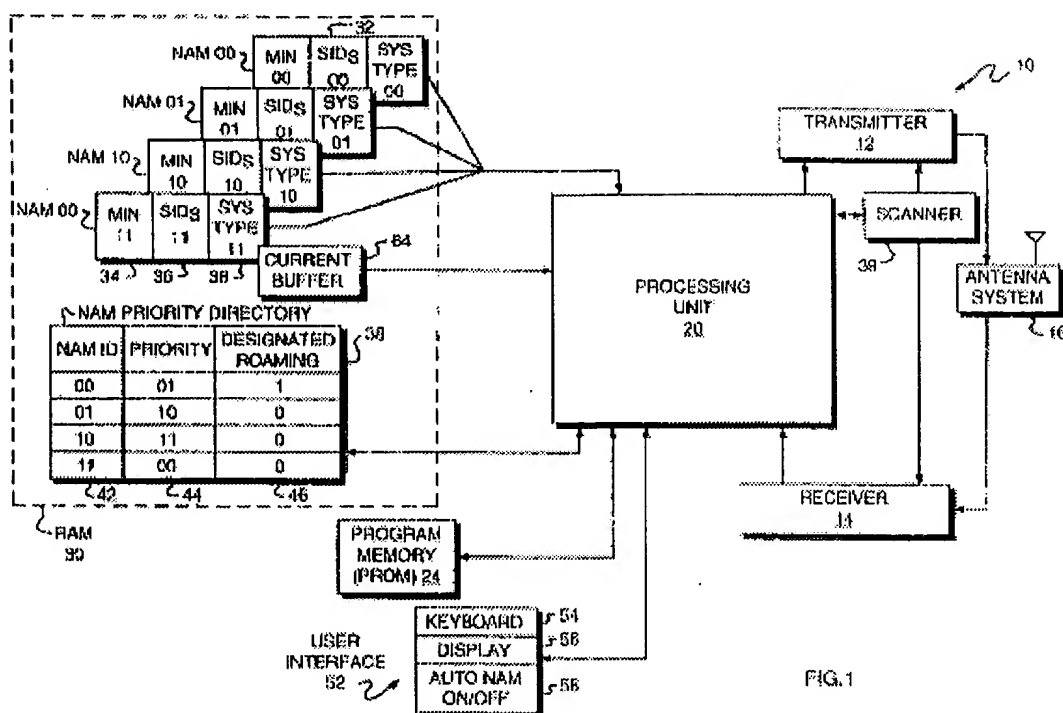


FIG. 1

9. Claims 1-7, 9-19, 22, 25, 26, 28, 33-37, and 39-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Cashman**.

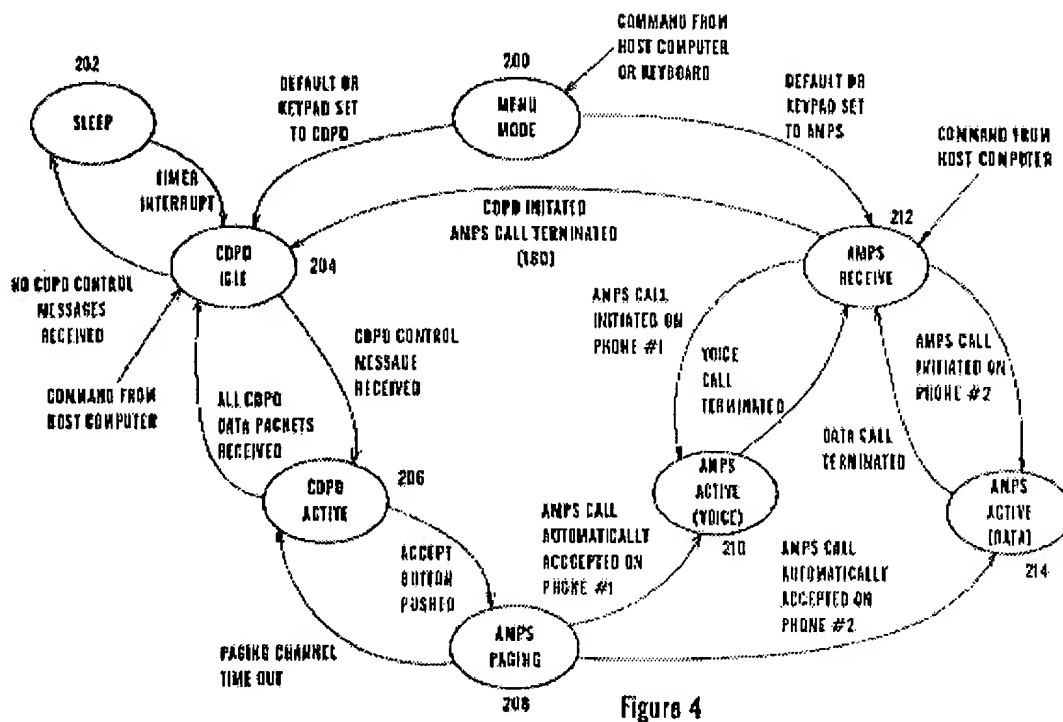
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10. Claims 1, 2, 4, 6, 7, 9-17, 25, 26, 28, 29, 33-37, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Schellinger, et al** (United States Patent 5,842,122).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The

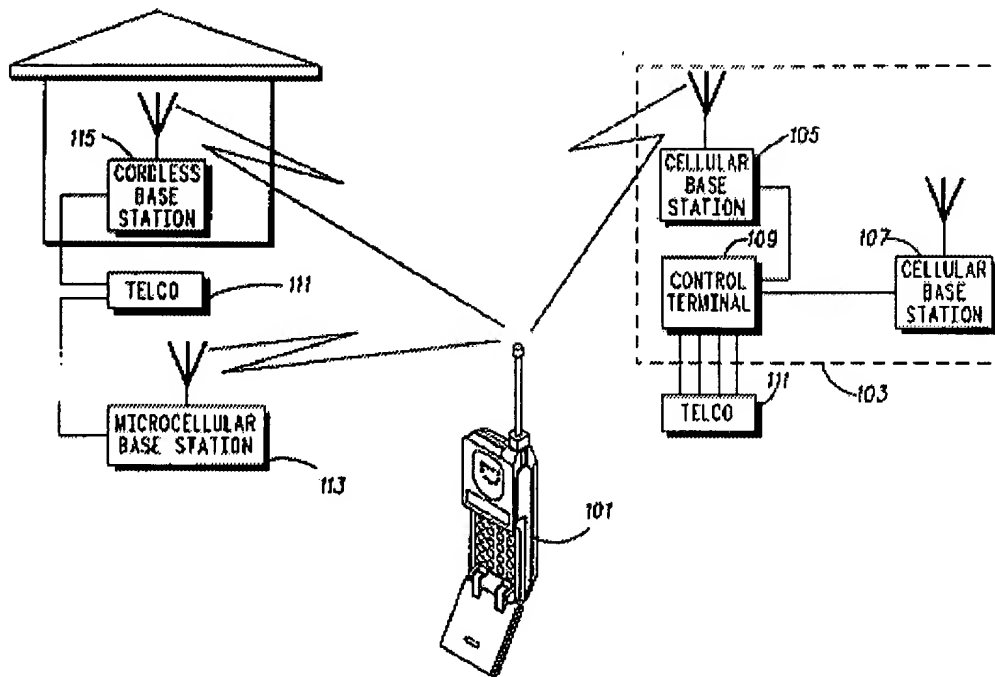
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It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



**FIG. 1**

11. Claims 1-7, 9-17, 22, 23, 25, 26, 28, 33-38, and 42-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Dent**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:



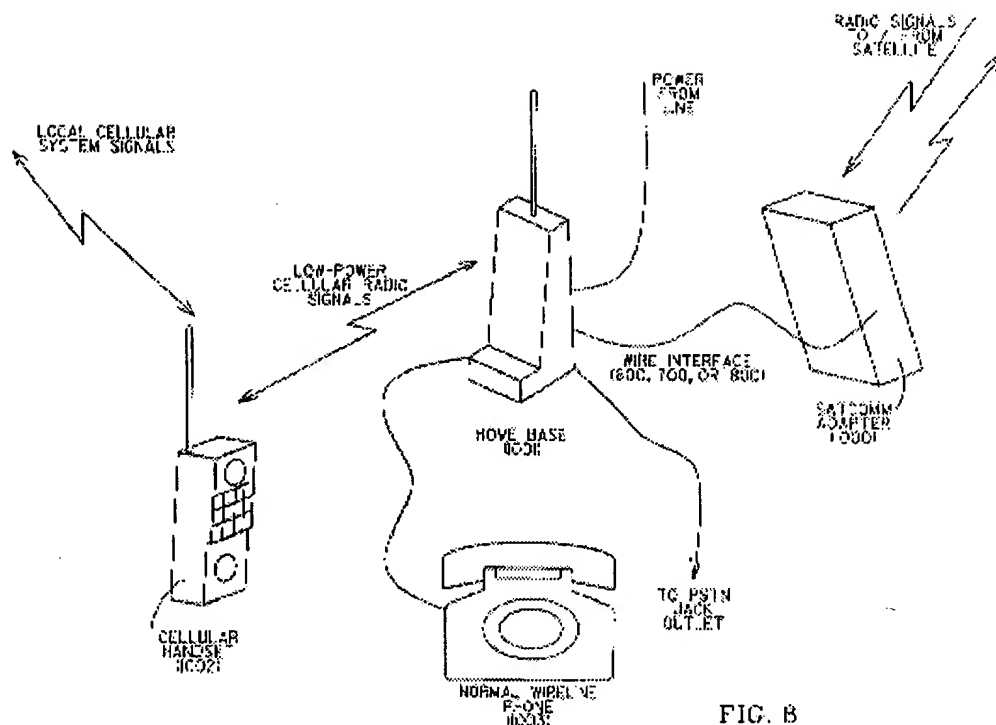
- (A) statements of intended use or field of use,
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- (C) "*wherein*" clauses, or
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This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

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12. Claims 1-6, 9-12, 15-26, 28, 33-38, 40, 41, 43, and 44 rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Shimosako**.

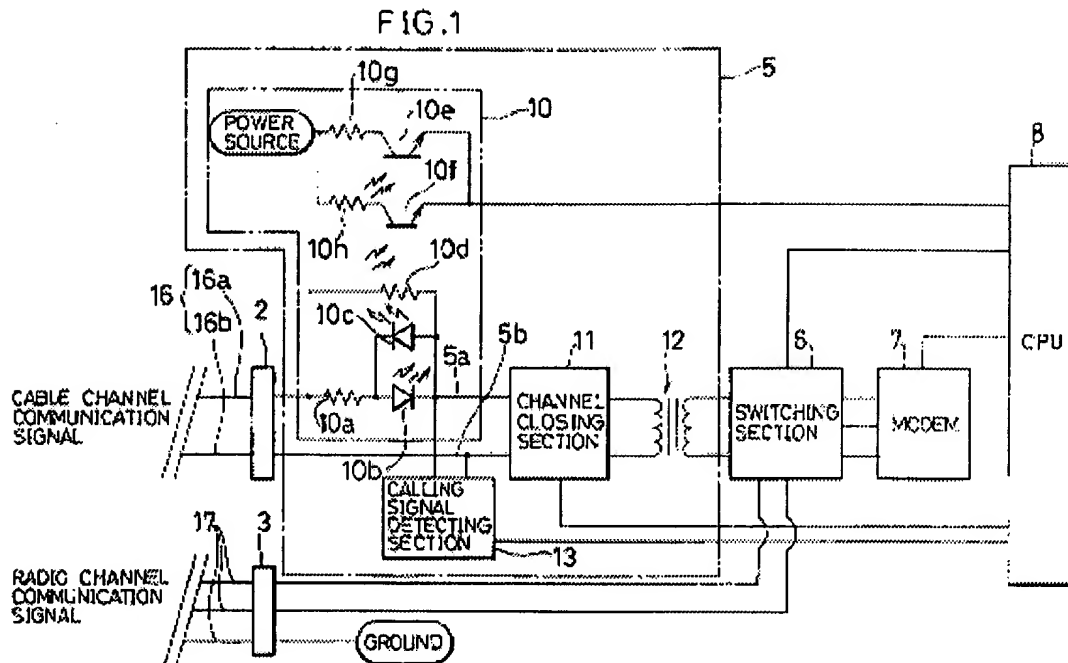
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The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



13: Claims 1-20, 22, 24-26, 28, 33-37, 39, 40, 43, and 44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Seazholtz, et al.**

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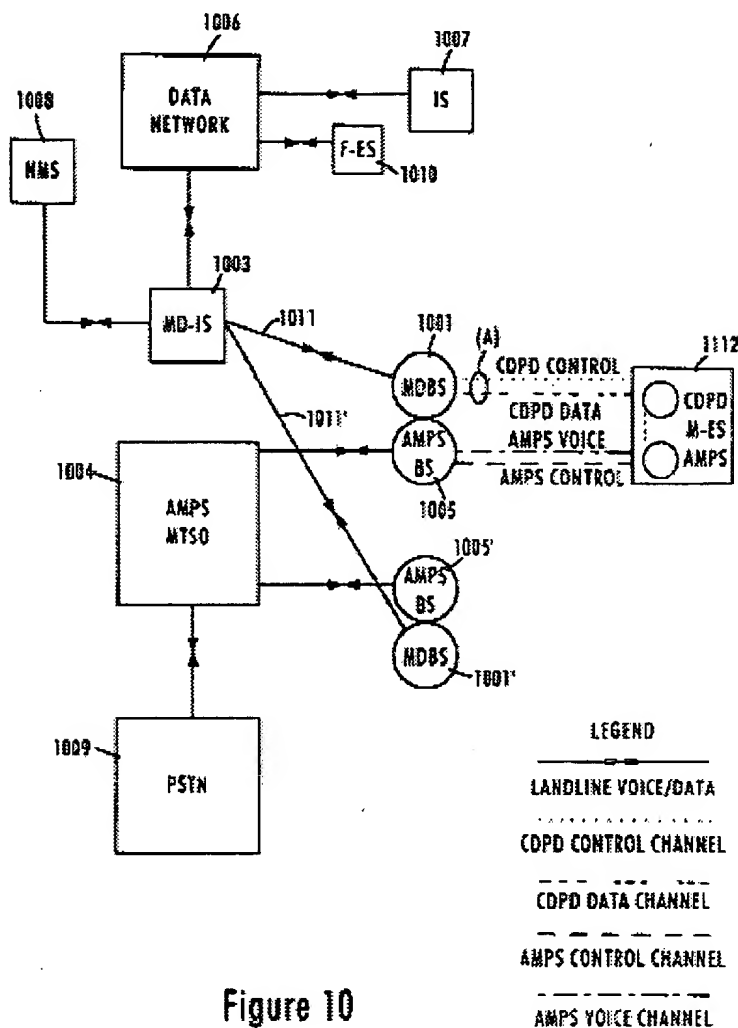
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- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
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It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



**Figure 10**

14. Claims 1, 2, 4, 5, 9-17, 26, 28, 33-37, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Molne**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate

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whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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*FIG. 3*

PRIORITY	INFORMATION FIELD	MODE	POINTER
1	HONE PLAN	PCS1900	SIM (6F07)
2	PREFERRED PLANS	PCS1900	SIM (6F30)
3	HONE SID	AMPS	SIM (XXXX)
4	ANY OTHER PLANS	PCS1900	NONE
5	PREFERRED SIDS	AMPS	SIM (YYYY)
6	PREFERRED SIDF (A OR B)	AMPS	SIM (ZZZZ)
7	ANY OTHER AMPS NETWORK	AMPS	NONE

*FIG. 4*

MODE	POINTER
0	6F07
0	6F30
1	XXXX
0	0000
1	YYYY
1	ZZZZ
1	0000

15. Claims 1-4, 12-17, 23, 26, 33-36, and 43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Blakeney, II, et al.**

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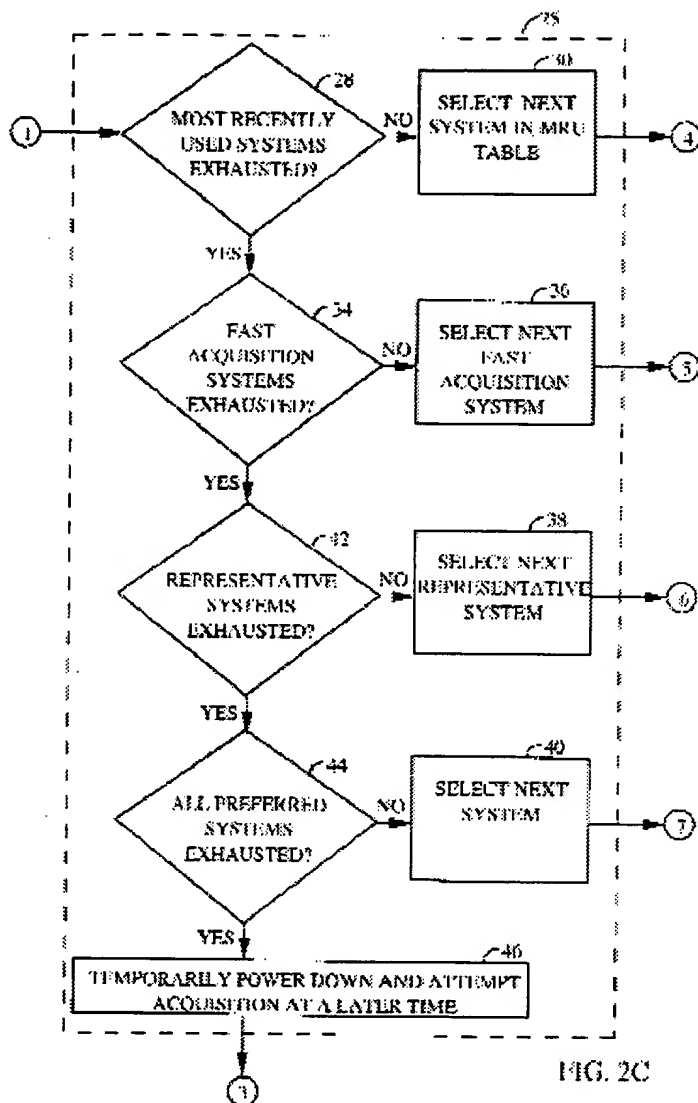
following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
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The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



16. Claims 1-4, 12-17, 23, 26, 33-36, and 43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Kukkohovi**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes

optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

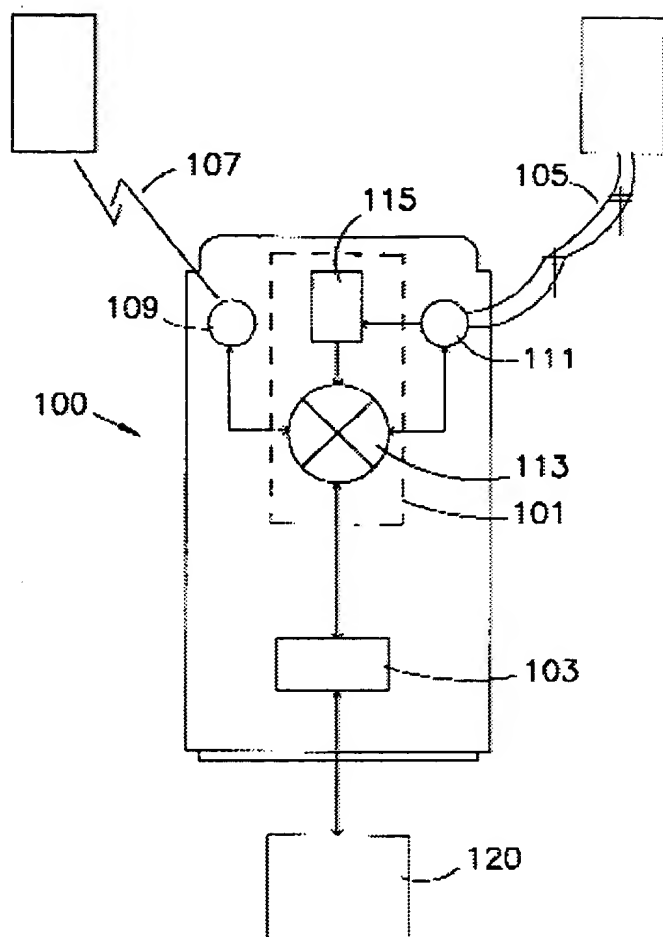


FIG. 1

18. Claims 1-4, 6, 7, 9, 10, 20, 22, 25-28, 33, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Rabe, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes

optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

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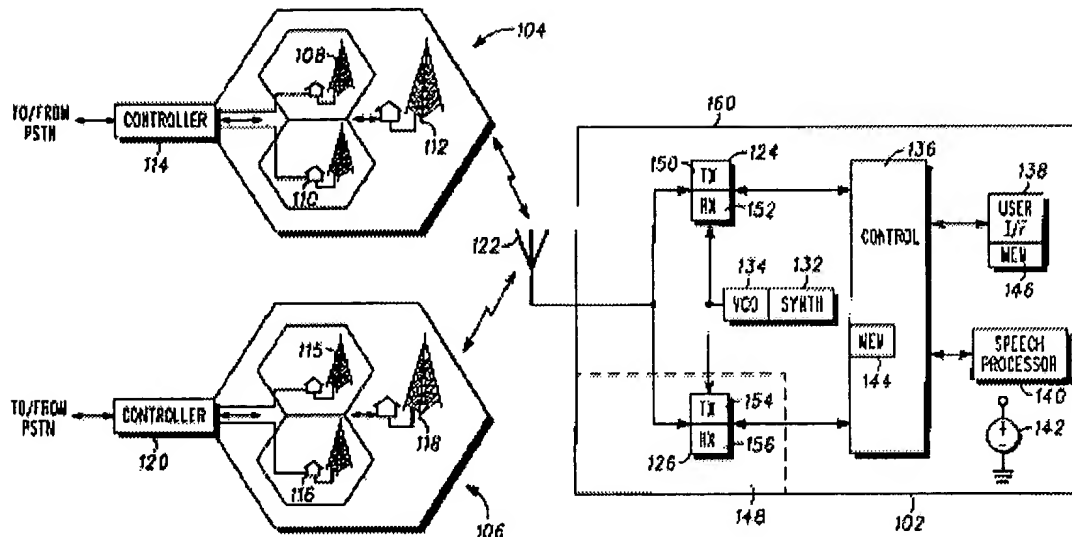


FIG. 1

**Claim Rejections - 35 USC § 103**

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.



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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claims 8, 29, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan**.

**Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan**

disclose all subject matter claimed except for an explicate showing of an Internet connection and standard jacks. The examiner takes Official notice that an Internet connection and standard jacks, like RJ-11, RJ-45, and modular eight-pin jack, are well known in telecommunication systems. Hence, it would have been very obvious at the time the claimed invention was made to incorporate the well known use of of an Internet connection and standard jacks in the method and apparatus of **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** in order to access internet service like e-mail and to attach standard telecommunication equipment to the apparatus or to attach the apparatus to standard telecommunication systems.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The

following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

22. Claim 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** in view of **Comer, et al**.

**Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** disclose all subject matter, except for one of the operation conditions is the determination of whether the transmission is occurring during peak or off-peak periods. **Comer, et al** teaches the use of one of the operation conditions is the determination of whether the transmission is occurring during peak or off-peak periods in a method of selecting a transmission system for the purpose of minimizing interference to normal control operations on the control channel, the

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cellular communications device transmits the selected data during certain off-peak times of operation for the system. Hence, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to incorporate the use one of the operation conditions is the determination of whether the transmission is occurring during peak or off-peak periods as taught by Comer, et al, in the method of **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** in order to minimize interference to normal control operations on the control channel, the cellular communications device typically transmits the selected data during certain off-peak times of operation for the system.

### ***Response to Arguments***

23. Applicant's arguments filed July 13, 2001 have been fully considered but they are not persuasive.

Enablement requirement of 35 USC 112 is satisfied if the specification contains description that enables one skilled in the art to make and use the claimed invention (Fiers v. Sugano, 25 USPQ2d 1601). The examiner, in holding that disclosure is not enabling, can rely upon sound scientific reasoning as acceptable alternative to patents and printed publications. Lack of working examples is not controlling in determining whether disclosure meets enablement requirement of 35 USC '112. A patent applicant who chooses to forego exemplification and bases utility on broad terminology and general allegations

runs risk that, unless one with ordinary skill in art would accept allegations as obviously valid and correct, examiner may properly ask for evidence to substantiate them (Ex parte Sudilovsky, 21 USPQ2d 1702).

The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed.

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "*inherent*" or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). In response to Applicant's argument, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "*teach*" what the subject patent teaches. Assuming that a reference is properly "*prior art*," it is only necessary that the claims under consideration "*read on*"

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something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "*fully met*" by it. It was held in In re Donohue, 226 USPQ 619, that, "*It is well settled that prior art under 35 USC §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it...Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention.*" Clear inference to the artisan must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be "*given the broadest reasonable interpretation consistent with the specification.*" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). "*Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102.*" Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "*teaches away*" from the invention is inapplicable to an anticipation analysis.

Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., simple and transparent to the user, transparent manner, without disruption to the user, automatically selecting, selection between a wired and wireless transmission) are not recited in some of the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

If applicant claims his invention so broadly, it should not come a surprise that the claims are also examined broadly.

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Erving, et al** disclose a wireless terminal having digital radio processing with automatic communication system selection capability.

**Bamburak, et al** show a method for selecting a wireless service provider in a multi-service provider environment using a geographic database.

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25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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27. If applicants request an interview after this **final rejection**, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing.

Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration.

Interviews merely to **restate arguments** of record or to **discuss new limitations** which would require more than nominal reconsideration or new search will be denied. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday through Thursday, 9:30 to 5:30, EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **DAINIEL HUNTER** can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.



Application/Control Number: 09/350,197

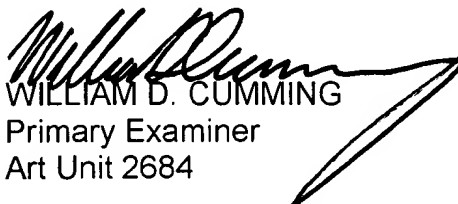
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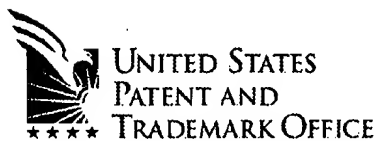
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

  
WILLIAM D. CUMMING  
Primary Examiner  
Art Unit 2684

wdc  
August 6, 2001



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